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In re Application of :
Bargain *et al* :
U.S. Application No.: 10/590,485 :
PCT No.: PCT/US2005/005597 :
Int. Filing Date: 24 February 2003 :
Priority Date: 25 February 2004 :
Attorney Docket No.: 049411-0340 :
For: DETECTION OF RESONATOR :
MOTION USING PIEZORESISTIVE :
SIGNAL DOWNMIXING :

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 26 November 2007.

BACKGROUND

On 24 April 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicants were given two months to respond with extensions of time available.

On 26 November 2007, applicants filed a response which was accompanied by, *inter alia*, the subject petition, a declaration signed by seven of the eight named inventors; copies of emails and a cover letter dated 16 November 2007; a statement of facts; a five-month extension and fee; and the petition fee of \$200.00.

DISCUSSION

Applicants claim that co-inventor, Darron K. Young, cannot be located after a diligent effort and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 24 April 2007.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventors cannot be located or refuse to cooperate; (3) a statement of the last known addresses of the nonsigning joint inventors; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

Concerning item (1), the petition fee of \$200.00 has been paid. With regards to

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item (3), the last known address of the nonsigning co-inventor is listed as:

430 Gerona Avenue
San Gabriele, CA 91775
Cambridge, MA 02139

Regarding item (2), applicants' burden in showing that an inventor cannot be located is explained in section 409.03(d) of the MPEP which states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

In this case, petitioners have submitted a statement of facts detailing the steps taken to locate the whereabouts of the nonsigning inventor signed by Leon Radomsky. Petitioners also submitted documentary evidence in the form of copies of several emails and a letter dated 16 November 2007 sent to the last known address of the nonsigning inventor.

However, petitioners have not submitted evidence showing that any attempt was made to locate Mr. Young using the internet and telephone directory to search for his address and/or telephone number. These efforts are not extraordinary and are required to meet the 'diligent effort' standard needed to satisfy item (2) above. Documentary evidence of these searches should be provided in any renewed petition.

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by seven of the eight co-inventors on behalf of themselves and the nonsigning joint inventor. The residence, citizenship and mailing address of all eight inventors are recorded on the declaration. However, the declaration signed by Jessica Arlett contains a non-initialed, non-dated alteration on the declaration. A new declaration executed by Ms. Arlett is required. See 37 CFR 1.52(c)(1).

For these reasons, items (2) and (4) of 37 CFR 1.47(a) are not yet complete.

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CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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